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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91217589
Party	Defendant J & N Sales, LLC
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RHYTHM HOLDING LIMITED,	)	Opposition No. 91-217589
	)	
Opposer,	)	
	)	
v.	)	In the Matter of:
	)	
J & N SALES, LLC,	)	Application No. 86/050,581
	)	
Applicant.	)	Mark: RHYTHM IN BLUES
	)	
	)	

Attorney Ref. 256.612

Applicant J & N Sales, LLC hereby moves for reconsideration of the Board's August 29, 2015 interlocutory decision that (1) deemed the applicant's motion to compel answers to its interrogatories moot on the ground that the opposer interjected new arguments and objections in response to applicant's motion, requiring that a new motion be filed, and (2) denied the applicant's motion to compel the production of documents and things pursuant to Rule 2.120(e)(1), albeit recognizing that applicant's counsel detailed its issues with opposer's objections in a letter to its counsel, which issues opposer's counsel declined to engage in an e-mail finally advising that opposer "stands by its objections."

In this proceeding, opposer objected to all 21 of the applicant's interrogatories, disingenuously asserting that they exceeded the limit imposed by Rule 2.120(d), purporting to find as many as 182 subparts in just one interrogatory composed of only 52 words. After an exchange of correspondence that failed to resolve the dispute raised by opposer's objection, including a narrow construction of its interrogatories offered by applicant, applicant moved to compel answers to its interrogatories. In response to the motion, opposer waived its objection as to their number, adopting the construction that applicant had offered (Response to Motion at

4), and interposed a set of new objections on different grounds. Applicant addressed those new grounds in a reply brief. In a “response” to applicant’s reply brief, opposer argued that applicant’s treatment of opposer’s new grounds in a reply was improper and, instead, that applicant must begin anew its efforts to resolve the dispute raised by opposer’s failure to answer applicant’s interrogatories by addressing with opposer its new grounds and then filing a second motion to compel answers to the same interrogatories. Opposer’s second response was ultimately rejected as an improper surreply, but not before the interlocutory attorney adopted opposer’s rationale expressed therein and denied opposer’s motion as moot in view of opposer’s new arguments.

A party is required to file but one motion to compel an answer to an interrogatory. The motion is directed to the interrogatory, regardless of the objection. The interposition of new arguments and objections after a motion has been filed cannot moot the motion merely because a new set of objections have been made. Such a practice would render motions to compel an endless endeavor, with respondents being permitted to interpose one new objection after another, postponing a decision on the motion indefinitely.<sup>1</sup> Where an initial objection is made pursuant to Rule 2.120(d), the responding party will be provided an opportunity to object in substance to a new set only when the Board makes a finding that the interrogatories exceeded the limit on subparts. TBMP 405.03(e). But no such determination was made on this motion, nor was it determined that the number was not exceeded, due to opposer’s waiver.<sup>2</sup> Instead, opposer caused applicant to move to compel, then waited until it was required to

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<sup>1</sup> Contrary to the Board’s view (Decision at 1), it is opposer’s second run at applicant’s interrogatories with a new set of objections, and not applicant’s reply to those objections, that is “newly assert[ed]” in the proceeding. Rule 2.120(e)(1) requires a good faith effort to resolve a discovery dispute *before* a motion is filed, not after the respondent presents new grounds that are appropriately addressed in a reply brief (see TBMP 502.02(b)). The Board’s decision turns these rules on their heads.

<sup>2</sup> Absent any determination on the merits of its Rule 2.120(d) objection, due to its abandonment thereof, opposer’s second set of objections was untimely, having been served far more than 30 days after service of applicant’s interrogatories. 37 CFR 2.120(a)(3). Accordingly, the significance attributed to opposer’s inability to file a surreply (Decision at 2) was misplaced.

respond before it abandoned its initial objection and presented new objections. The result is no different, no more excusable, and no more avoidable than had opposer initially objected in substance, as it is now apparent it could and should have.<sup>3</sup> It should not be countenanced. The interlocutory attorney's decision reflects a fundamental misapplication of interrogatory motion practice, as well as of the Board's practice following initial objections as to subparts that may have been appropriate under different circumstances, but here constituted clear error.

## **II. Applicant Made a Sufficient Good Faith Effort to Resolve Opposer's Objections**

The Board denied applicant's motion to compel opposer to comply with applicant's requests for production (Decision at 2) on the ground that applicant sent but one letter to opposer's counsel detailing its issues with opposer's objections (Exhibit E), which was followed by a single-line e-mail from opposer's counsel that it "stands by its objections" (Exhibit F). It is respectfully submitted that a good faith effort to resolve a discovery dispute should not be measured by the number of communications alone but, more importantly, by the content of those communications. Opposer's rigid stance that it will stand by its objections, without addressing in the least the concessions made and explanations provided by applicant, made any further advances by applicant futile by any measure of reasonableness. The Board clearly erred in holding applicant to a higher standard.

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<sup>3</sup> It is also apparent that, in its "response" to applicant's reply brief, opposer could have addressed applicant's arguments regarding opposer's new objections directly instead of, or in addition to, seeking to invert the rules and common sense to its procedural advantage. Addressing those arguments could have been considered by the Board as readily as the Board espoused the implausible view advanced by the opposer in its "response" that applicant's reply brief was not "in fact" a reply brief but, rather, a new motion to compel, on the dubious premise that a newly asserted objection requires a new motion to compel an answer to the same interrogatory. In the nearly a month that has passed since the Board issued its decision, admonishing the parties that they are "under an obligation to get together and attempt in good faith to resolve their differences," and after more than three months since applicant communicated its positions regarding opposer's newly asserted objections in its reply brief, winnowing its challenges to fewer and a narrower scope of opposer's objections, opposer has made no effort to continue the discussion by responding to applicant's outstanding efforts.

Moreover, the Board's decision lets stand opposer's objections to applicant's requests on as troubling grounds as that it is not in possession of information regarding the adoption of its mark because it acquired the mark from a predecessor when, in fact, its predecessor is its principal, and boilerplate objections of irrelevance without further explanation. The Board then criticized applicant (Decision at 2) for failing to cite to an authority supporting each of its requests as enumerated in its TBMP 414, which is merely a list of examples of relevant materials that can be sought in discovery. The list is by no means exhaustive, nor is it intended to be. Applicant, for example, made it clear that its discovery requests related to matters that may very well reveal admissions regarding third party use of the many coexisting apparel marks that merely incorporate the work "rhythm," including marks the applicants for which opposer settled by delineating usage, markets and channels of trade in manners that support applicant's defenses. In that regard, applicant, notwithstanding the Board's assessment to the contrary (Decision at 3), limited and supported its requests for "all" documents related to that subject, as well as, for example, requests seeking documents supporting opposer's claims in any manner, circumscribing its requests to allow for examples of advertising, sales and other uses of the mark as sufficient responses. Motion at 3-4.

The appropriateness of discovery requests are often made on a case-by-case basis and need not always be supported to specific authority beyond FED.R.CIV.P. 26(a)(1) regarding their proper scope, including citation to one of the examples listed in TBMP 414 which itself states that the list is "illustrative, not exhaustive." The Board cited no authority but its TBMP 402.01 for the broad and unspecific recognition that the scope of discovery in Board proceedings may be narrower than in civil actions. The authority cited there in the TBMP, *Frito-Lay North America, Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904 (TTAB 2011), addresses the special treatment of e-discovery, and the text of TBMP 402.01 limits discovery based on issues that are present in a civil action but not necessarily present in a particular Board proceeding, such as infringement and use in commerce, and do not purport to limit the scope of discovery

within a matter properly at issue in the Board proceeding. Both were, therefore, misapplied in this case. The test in Board proceedings remains whether the requests are "*calculated to lead to the discovery* of admissible evidence" and not whether it can be proved in advance that all of the material within the scope of the request is relevant, material, and admissible. *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988).

Aside from opposer's wholly insufficient, boilerplate objections that applicant's requests are "irrelevant," without more (a non-objection that brought us to this motion and which applicant has argued constituted a waiver by opposer of any objection to those requests), applicant's requests are supported by the rules governing the scope of discovery. Opposer has not responded to Request No. 1, seeking the documents identified in response to applicant's interrogatories, since dropping its Rule 2.120(d) objection as to subparts. Requests No. 3, 11 and 14, which seek documents concerning third party uses of "rhythm" marks known to opposer, are certainly not appropriately addressed by production of 'representative samples.' TBMP 414(9, 10) n. 16, 18. The same can be said for Request No. 10, seeking all documents concerning opposer's awareness of applicant's adoption and use of its mark to which opposer now objects (TBMP 414(4) n.5), Request No. 15, concerning consumer recognition of marks comprising the common element of the parties' marks (TBMP 414(9) n.16), Request No. 20, seeking all documents in which opposer defines or identifies its target markets and channels of trade (TBMP 414(3) n.4), and Request No. 22, seeking all of opposer's documents that refer to applicant's mark or its goods (TBMP 414(4) n. 5). Production only of "representative documents" in response to these requests would unfairly permit opposer to produce only those it deems favorable, while withholding those prejudicial, to its case.

Opposer maintains its objections in their entirety, viz., it does not offer to produce even representative samples, as to Request No.12 concerning the types of products sold by opposer under its mark, Request No. 13 concerning opposer's market research and assessment of its target markets (TBMP 414(3) n.4), Requests No. 14 and 15 (see paragraph above), Request

No. 18 concerning opposer's expansion (TBMP 414(8) n. 15) and request No. 19, seeking opposer's communications regarding mode of presentation, commercial impression and reputation of its marks (TBMP 414 and notes regarding likelihood of confusion, *passim*).

As in the case of opposer's objections to applicant's interrogatories, in the month that has passed since the Board issued its decision, admonishing the parties that they are "under an obligation to get together and attempt in good faith to resolve their differences," and after more than four months since applicant communicated its revised positions regarding opposer's objections in its motion, winnowing its challenges to fewer and a narrower scope of opposer's objections, opposer has made no effort to continue the discussion and has not responded to applicant's inquiry in that regard. It is not clear what the interlocutory attorney understood applicant might do at this stage to budge opposer from its steadfast position of standing by its original objections other than to move to compel, the very path applicant sought to avoid.

### **III. Conclusion**

For the foregoing reasons, it is respectfully submitted that the Board reconsider its interlocutory decision of August 29, 2015 and resolve the interrogatory dispute on the papers submitted, with the exception of opposer's surreply and taking into account the delinquency of opposer's second set of objections, that the Board reconsider and grant applicant's motion to compel opposer's compliance with its discovery requests properly on the merits, as further supported herein, and that the discovery period and subsequent dates be extended 30 days from a decision on this motion.

Respectfully submitted,

New York, New York  
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Certificate of Service

I hereby certify that, on September 28, 2015, a copy of the foregoing Motion for Reconsideration was served upon opposer's counsel of record by first class mail, postage prepaid, in an envelope addressed to:

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